

REMARKS

Claim 19 is added, claim 17 is canceled without prejudice, and therefore claims 10, 12 to 16 and 19 are now pending in the present application.

It is respectfully requested that the present application be reconsidered since all of the presently pending claims are allowable.

Applicants thank the Examiner for acknowledging the claim for foreign priority and for indicating that all certified copies of the priority documents have been received.

The drawings were objected to because the lettering and numbering were difficult to read. The drawings have been corrected to include typewritten lettering and numbering. Approval and entry are respectfully requested, as is withdrawal of the objections.

Claims 10 and 12 to 17 were rejected under 35 U.S.C. 112, second paragraph, as indefinite.

While the rejections may not be agreed with, to facilitate matters, claims 10, 12, 13 and 15 have been rewritten to better clarify the claimed subject matter. The terms “producing” and “produced” have been revised to “creating” and “created” to better clarify the recited subject matter. It is now clear that in one operation of method claim 10, a patterned porous region is *created*. In another, a functional layer is *created*. Subsequently (that is, after a patterned porous region is created and after a functional layer is created), the functional layer is *exposed* by using the porous region at least partially as a sacrificial layer.

Also, claim 10 specifies that the porous region be *created* before the functional layer. In particular, claim 10, as presented, clearly indicates that the *creating* of the functional layer does not include the *exposing* of the functional layer. The *creating* of the functional layer occurs before the *exposing* of the functional layer.

The Office Action also expresses concern that claim 17 is redundant as to claim 10. While the rejection may not be agreed with, to facilitate matters, claim 17 has been canceled without prejudice.

Accordingly, claims 10 and 12 to 17 are allowable, and withdrawal of the indefiniteness rejections is therefore respectfully requested.

Claims 10, 12 and 17 were rejected under 35 U.S.C. § 102(b) as anticipated by Sakata et al., JP 06-324074. Claims 10, 12, 13 and 17 were rejected under 35 U.S.C. § 102(b) as anticipated by Benz et al., U.S. Patent No. 5,542,558.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 17 has been canceled without prejudice.

Claim 10, as presented is to a method for producing a micromechanical component using a sacrificial layer, including: creating a patterned porous region in a silicon substrate; creating a functional layer above the porous region; and subsequently exposing the functional layer, the porous region being used at least partially as the sacrificial layer; in which the porous region is created first and then the functional layer.

It is respectfully submitted that a review of the cited portions makes plain that they do not identically describe (or suggest) the features of claim 10, as presented.

Also, previously presented claims 10 and 12 were allowed over the Sakata and Benz references. Claims 10 and 12, as presented, include features like those of previously presented and allowable claims 10 and 12, and are therefore also allowable for the reasons advanced in connection with the prior Office Action.

As to paragraph eleven (11) of the Office Action, claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Sakata or Benz references.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 14 depends from claim 10, as presented, and is therefore allowable for essentially the same reasons as claim 10, as presented. Further, claim 14, as presented, was previously allowed over the Sakata and Benz obviousness rejection. Accordingly, claim 14 is allowable over the Sakata and Benz obviousness rejection.

New claim 19 does not add any new matter and is supported by the present application, including the specification. Claim 19 depends from claim 10, as presented, and is therefore allowable for the same reasons. Also, claim 19 includes the features of etching off in a dry-chemical manner the porous region below the functional layer; patterning the functional layer; and creating additional layers above the porous region, the additional layers cooperating with the functional layer and being provided in patterned form; in which the creating of the porous region includes creating a doped first region in the substrate in which no pores will form, and subsequently creating the porous region. These features are not disclosed by the applied references, so that claim 19 is allowable for this further reason.

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Accordingly, claims 10, 12 to 16 and 19 are allowable.

CONCLUSION

In view of the foregoing, all of pending claims 10, 12 to 16 and 19 are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested, as is allowance of the application.

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Respectfully submitted,

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